

REMARKS

Applicants affirm the election of the Group I invention including claims 1-13. Applicants further cancel claims 14-16 as being directed to the non-elected invention subject to Applicants right to file a divisional application to the nonelected invention.

Claims 1-8 and 10-13 have been amended. Claims 14-16 have been canceled and new claims 17-20 have been added to the application. The claims now remaining in the application are claims 1-13. Applicants most respectfully submit that all the claims now present in the application are in full compliance with 35 U.S.C. §112 and are clearly patentable over the references of record.

The objection to claims 1-5, 7-8 and 10-13 for informalities in that some of the claims contained the phrase "characterized in" have been obviated by the amendment to the claims. Therefore, it is most respectfully requested that the objection to the claims be withdrawn in view of the amendments to the claims. The Examiner's help suggestions for amending the claims are appreciated.

The rejection of claims 1-13 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been carefully considered and in view of the amendment to the claims, it is believe that this rejection has been obviated. Accordingly, it is most respectfully requested that this rejection be withdrawn.

The rejection of claims 1-5, 11 and 13 under 35 U.S.C. §103(a) as being unpatentable over Ikuta, also the rejection of claims 1 and 6-8 as being unpatentable over Ikuta in view of Kolla et al. and claims 1, 9-10 and 12 as being unpatentable over Ikuta in view of DE 19815992 has been carefully considered but is most respectfully traversed in view of the following comments.

Applicants wish to direct the Examiner's attention to the basic requirements of a prima facie case of obviousness as set forth in the MPEP § 2143. This section states that to establish a prima facie case of obviousness, three basic criteria first must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to

modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Section 2143.03 states that all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicants also most respectfully direct the Examiner's attention to MPEP § 2144.08 (page 2100-114) wherein it is stated that Office personnel should consider all rebuttal argument and evidence present by applicant and the citation of *In re Soni* for error in not considering evidence presented in the specification.

Applicants wish to point out that in fact, Ikuta U.S. Patent 5,290,627 corresponds to DE 42 11 010 A which was cited in the international search report. Applicants believe that the subject matter of the present claims is non-obvious over the disclosure of this document as would be appreciated by one of ordinary skill in the art to which the invention pertains.

Applicants wish to note that there may be a misunderstanding as to the term "fibril content" which is used in claim 1. As is evident from Applicants' specification, what is meant by the terms "fibrils" and "fibril content" can be seen from page 1, lines 13 to 20, page 9, lines 2 to 10, and lines 31 et seq. Applicants would like to mention that in the description the term "fibril fraction" is used instead of "fibril content". However, if the Examiner believes that it would be helpful, Applicants would amend claim 1 to replace the term "fibril content" by the term "fibril fraction".

In particular, it is stated that in order to determine the fibril fraction, elementary fibres are examined under the microscope and the area occupied by the fibril and the

area occupied by the elementary fibres are determined. The fibril fraction is the area of the fibrils divided by the sum total of the areas occupied by the fibrils and by the elementary fibres. Furthermore, on page 10, line 10, a formula is given how the fibril fraction in area per cent can be converted into a fibril fraction by weight. However, this conversion is only an approximation.

In the '627 patent, paper-like friction materials for operating in oil are disclosed. These friction materials contain fibrillated ramie fibers. However, the '627 does not contain any disclosure as to the fibril content (or fibril fraction) as defined in the present application. It is only described that the friction material contains 5 to 70 wt. % of fibrillated ramie fibers. However, this percentage corresponds to the statement made in claim 4 of the present application, namely that the weight fraction of the fibres is between 10% and 90%. Therefore, '627 does not make any statement as to the fibril content as defined in the present application.

The Examiner argues that the '627 reference discloses that the fibers have a fibril content of 5 to 70%. This is not correct. In fact, 5 to 70 wt. % of the fibers are fibrillated fibers. According to the present invention, the area of the fibrils relative to the area of the elementary fibres are measured. If, for example, all elementary fibres were fibrillated, according to '627, 100 wt. % of the friction material would be fibrillated. However, according to the measurement of the present invention the fibril content would e.g. only be under 30% if the degree of the fibrillation, i.e. how many fibrils every elementary fibre has, is low. Furthermore, please note that on pages 2 and 3 of the present application, it is particularly pointed out that the degree of fibrillation, as defined in the application, is important. Given a very high fibril content such fibres can substitute fibrillated aramid fibres in many sectors. The '627 patent discloses that the fibrillated ramie fibers should have a high value of freeness. However, the value of freeness affects not necessarily the fibril content, since the fibres could also be only shortened. This has particularly pointed out in the present application on page 14, lines 31 et seq.

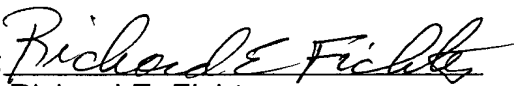
Therefore, Applicants believe that the arguments of the Examiner against the subject matter of the presently claimed invention in view of the disclosure of the '627

patent are not justified. The ranges cited in claim 1 of the present application and in the '627 reference are just not comparable. They concern different matters.

Thus, the further rejections of the dependent claims as set forth in the Official Action are not justified and should be withdrawn. The deficiencies of the primary reference is not overcome by the teachings of the secondary references. As to DE 198 15 992 Applicants wish to note that this German application has been filed in April 1998, however, it has only been published on October 14, 1999. This is later than the priority date of the present application. Accordingly, it is most respectfully requested that these rejections be withdrawn in view of the amendments to the claims and the foregoing comments.

In view of the above comments and further amendments to the claims, favorable reconsideration and allowance of all of the claims now present in the application are most respectfully requested.

Respectfully submitted,
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Marked-Up Version of Changes Made

IN THE CLAIMS:

Please cancel claims 14-16 without prejudice or disclaimer.

Please replace claims 1-8 and 10-13 with the following amended claims.

1(Amended). Reinforcing [and/or process] fibres based on vegetable fibres whose elementary fibres are fibrillated, [characterized in that] comprising the elementary fibres have a fibril content greater than 3 area per cent and less than 50 area per cent.

2(Amended). Fibres according to claim 1, [characterized in that the] comprising fibres [are] based on flax, hemp, sisal, jute or ramie fibres.

3(Twice Amended). Reinforcing [and/or process] fibres comprising a mixture of fibres according to Claim 1 and fibrillated aramid fibres.

4(Twice Amended). Fibres according to Claim 3, [characterized in that] comprising the weight fraction of the fibres is between 10% and 90%.

5(Twice Amended). Fibres according to Claim 3, [characterized in that] comprising the weight fraction of the fibres is between 50% and 80%.

6(Twice Amended). Reinforcing [and/or process] fibres comprising a mixture of fibres according to Claim 1 and shives.

7(Amended). Fibre according to claim 6, [characterized in that] comprising the weight fraction of the shives is less than 10%.

8(Amended). Fibre according to claim 6, [characterized in that] comprising the weight fraction of the shives is between 25 and 75%.

10(Amended). Additive according to claim 9, [characterized in that] comprising the weight fraction of the fibres is between 5 and 95% by weight.

11(Twice Amended). Friction lining, [characterized in that it contains] comprising fibres according to Claim 1.

12(Amended). Friction lining according to claim 11, [characterized in that] comprising tin sulphide are present in an amount of 0.5 to 90% by weight, based on the total amount of the lubricating materials.

13(Twice Amended). Gasket, [characterized in that it contains] comprising fibres according to Claim 1.